



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SW

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/668,196 | 09/24/2003 | Chan-Tung Chen | 3624-0129P | 4112 |

2292 7590 11/23/2004
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

| EXAMINER |
|-----------------|
| HUNTER, ALVIN A |

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3711 | |

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,196

Applicant(s)

CHEN ET AL.

Examiner

Alvin A. Hunter

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Newander (USPN 5643105).

Regarding claim 1, Newander discloses a golf club head comprising a striking plate mounted to a golf club head body, a hosel mounted to a side of the club head wherein the hosel has a reduced section, and a wrapping layer made of a lightweight material wrapped around the reduced section of the hosel (See Figures 1 through 4).

Regarding claim 13, Newander discloses that the hosel made be formed casting being that the portion of the hosel is integral with the club head (See Figure 1 and Column 1, lines 54 through 67).

Regarding claim 14, the limitation recited is a product by process, therefore, it is submitted that Newander meets the limitation because the same final product is achieved.

Regarding claim 15, the limitation recited is a product by process, therefore, it is submitted that Newander meets the limitation because the same final product is achieved.

Claims 1-3, 7, 9, 10, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagamoto (USPN 5647807).

Regarding claim 1, Nagamoto discloses a golf club head comprising a striking plate mounted to a golf club head body, a hosel 2 mounted to a side of the club head wherein the hosel has a reduced section, and a wrapping layer 5 and 6 made of a lightweight material wrapped around the reduced section of the hosel (See Figures 1 and 2).

Regarding claims 2 and 9, Nagamoto discloses the hosel further including an engaging hole for engaging with a shaft (See Figures 1 and 2).

Regarding claims 3 and 10, Nagamoto discloses the hosel having a top end distal to the club head body wherein a flange is formed on the top end of the hosel (See Figure 1).

Regarding claim 7, Nagamoto discloses the reduced section of the hosel extending to a joint area between the hosel and the striking plate (See Figure 1).

Regarding claim 13, Nagamoto discloses the hosel being casted or forged (See Column 2, lines 62 through 67).

Regarding claim 14, the limitation recited is a product by process, therefore, it is submitted that Nagamoto meets the limitation because the same final product is achieved.

Regarding claim 15, the limitation recited is a product by process, therefore, it is submitted that Nagamoto meets the limitation because the same final product is achieved.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagamoto (USPN 5647807) in view of Wheeler et al. (USPN 2458920).

Regarding claims 4 and 11, Nagamoto et al. does not disclose having at least one protrusion on the outer periphery of the reduced section of the hosel. Wheeler et al. discloses an attachment method wherein an outer surface has at least one protrusion in which the protrusion facilitates bonding (See Entire Document). Though the method is used on a shaft in conjunction with a clubhead, one having ordinary skill in the art would recognize that the attachment method can be used to facilitate bonding between other elements and therefore, would have been obvious to incorporate into Nagamoto et al. because it improves bonding.

Regarding claims 5 and 12, Nagamoto et al. does not disclose having at least one recess on the outer periphery of the reduced section of the hosel. As noted above regarding claim 4, Wheeler et al. discloses having protrusions for facilitating bonding. One having ordinary skill in the art would have seen placing the protrusions on the opposite element and recessed on the other element to be bonded to not result in any improvement over that noted in claim 4 and, therefore, would have been obvious to incorporate into Nagamoto et al. because it improves bonding.

Art Unit: 3711

Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagomoto et al. (USPN 5647807) in view of Tsuchida (USPN 5624330).

Regarding claims 6 and 8, Nagomoto et al. does not disclose an annular conical groove at the bottom of the reduced section of the hosel. Tsuchida discloses a joint structure for a golf club wherein Figure 3 shows an annular conical groove wherein a ferrule is received therein. The joint is clearly used to bonding two elements and one having ordinary skill in the art would see the joint as doing such, therefore, incorporate an annular conical groove to the bottom of the reduced portion of Nagomoto et al. would have been obvious.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

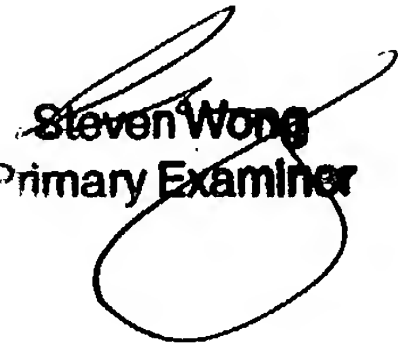
Application/Control Number: 10/668,196

Page 6

Art Unit: 3711

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAN
Alvin A. Hunter, Jr.


Steven Wong
Primary Examiner